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Serial No. 09/722,410
Response to Office Action dated August 5, 2005

REMARKS

Reconsideration and allowance of the subject patent application are respectfully requested.

Applicants acknowledge with appreciation the indication that claims 141-152, 171-182, 184-195, 208-219, 223-234 and 238-249 contain allowable subject matter.

Claims 202, 203, 205, 206, 220, 221, 235, 236, 250 and 251 were rejected under 35 U.S.C. Section 112, second paragraph, as allegedly being indefinite because of the use of the trademarks/tradenames Palm and Windows.

The presence of a trademark or trade name in a claim is not, per se, improper under 35 U.S.C. 112, second paragraph. MPEP Section 2173.05(u). As noted in MPEP Section 2173.02, in reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent.

With respect to claims 202, 203, 205, 206, 220, 221, 235, 236, 250 and 251, Applicants submit that "Palm operating system" and "Windows operating system" would apprise one of ordinary skill in the art of the scope of the claims. In any event, to advance prosecution, Applicants have amended these claims to refer to a "Palm-based operating system" and a "Windows-based operating system" along the lines of claim language present in previously-issued U.S. Patents (see, e.g., USPs 6,961,753; 6,956,477; and 6,918,093).

Based on these amendments, withdrawal of the Section 112, second paragraph, rejection of claims 202, 203, 205, 206, 220, 221, 235, 236, 250 and 251 is respectfully requested. These claims are not otherwise rejected and are therefore believed to be allowable.

Claims 140, 166-169, 201, 204, 207, 222 and 237 were rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over the Game Boy Programming Manual.

Applicants traverse this rejection.

Claims 140 and 201 each describes that background data is selectively written to the video storage as either character data or bitmap data so that backgrounds of the video game display are selectively rendered in a character mode or in a bitmap mode. The office action

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identifies no portion of the Game Boy Programming Manual that discloses or suggests the selective rendering of backgrounds in either a character mode or a bitmap mode and thus the office action fails to set forth a prima facie case of obviousness for claims 140 and 201. The office action states with reference to pages 47-51 that the system in the Game Boy Programming Manual includes "bitmap/character" memory for the transfer of "bitmap/character" data to a display memory. However, the referenced portion of the Manual only describes character RAM and BG character data. There is no mention of bitmap data or an ability to selectively render backgrounds in a character mode or in a bitmap mode as specified in claims 140 and 201. Consequently, withdrawal of the rejection of claims 140 and 201 as being made obvious by the Game Boy Programming Manual is respectfully requested.

Claims 166 and 204 each describes that a memory stores instructions that access two allocated frame buffers in the video storage to provide full motion video. The office action identifies no portion of the Game Boy Programming Manual that is alleged to disclose or suggest this feature. While the office action discusses the "memory address range" and "storing no more than ..." limitations, there is no mention of how the Manual discloses or suggests providing full motion video as claimed. Consequently, the office action fails to set forth a prima facie case of obviousness for claims 166 and 204 and for at least this reason withdrawal of the rejection of these claims is respectfully requested.

Claims 167 and 207 each describes that a memory stores instructions that control alpha blending of plural display windows. The office action identifies no portion of the Game Boy Programming Manual that is alleged to disclose or suggest this feature. While the office action discusses the "memory address range" and "storing no more than ..." limitations, there is no mention of how the Manual discloses or suggests control of alpha blending of plural display windows as claimed. Consequently, the office action fails to set forth a prima facie case of obviousness for claims 167 and 207 and for at least this reason withdrawal of the rejection of these claims is respectfully requested.

Claims 168 and 222 each describes that a memory stores instructions that control fade-in/fade-out of plural display windows. The office action identifies no portion of the Game Boy Programming Manual that is alleged to disclose or suggest this feature. While the office action

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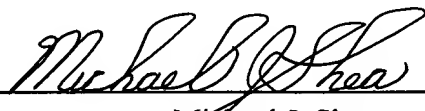Response to Office Action dated August 5, 2005

discusses the "memory address range" and "storing no more than ..." limitations, there is no mention of how the Manual discloses or suggests control of fade-in/fade-out of plural display windows as claimed. Consequently, the office action fails to set forth a prima facie case of obviousness for claims 168 and 222 and for at least this reason withdrawal of the rejection of these claims is respectfully requested.

Claims 169 and 237 each describes that a memory stores instructions that control performance of arithmetic operations on two selected surfaces and processing for up to 16 levels of semi-transparency. The office action identifies no portion of the Game Boy Programming Manual that is alleged to disclose or suggest this feature. While the office action discusses the "memory address range" and "storing no more than ..." limitations, there is no mention of how the Manual discloses or suggests control of performance of arithmetic operations on two selected surfaces and processing for up to 16 levels of transparency as claimed. Consequently, the office action fails to set forth a prima facie case of obviousness for claims 169 and 237 and for at least this reason withdrawal of the rejection of these claims is respectfully requested.

The pending claims are believed to be in condition for allowance and favorable office action is respectfully requested.

Respectfully submitted,

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